UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL ZOBEL,
THOMAS ECKEL,
DIETER WITTMANN and
BERND KELLER

Appeal No. 2005-1375
Application 09/890,148

REHEARING

Before WALTZ, KRATZ, and FRANKLIN[1], Administrative Patent Judges.

FRANKLIN, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants have submitted a Request for Rehearing (hereafter "Request") of our decision mailed September 30, 2005.

Beginning on pages 2-3 of the Request, appellants indicate that the Board misapprehended appellants' argument regarding Wittmann. On page 3 of the Request, appellants specifically state that what appellants argued was not that Wittmann failed to teach or guide one of ordinary skill in the art as whether to include a flame retardant, but that Wittmann failed to teach or suggest how to select any particular flame retardant. We disagree. We fully appreciated the fact in our decision mailed September 30, 2005, that Wittmann did not specify a particular flame retardant. See page 3 of the decision mailed September 30,

[1] The panel members have not changed; rather, a name change has occurred.

2005. That is, we specifically stated "although Wittmann does not provide specific examples of the types of flame retardants used in the molded composition, the examiner relies upon Pan for teaching this aspect of the claimed invention." Decision, page 3.

At the bottom of page 3 of the Request, appellants argue that the Board overlooked that the examiner failed to explain why one of ordinary skill in the art would have been motivated to consult Pan regarding use of a particular flame retardant. We disagree. On page 3 of our decision, we stated "the examiner explains that Pan teaches aluminum oxide as flame-retardants for aromatic polycarbonates. Appellants do not dispute that the kind of resins disclosed in Pan are similar to the molding compositions as set forth in Wittman. Hence, incorporating the teachings of Pan (particular type of flame retardant additive) into the molded compositions of Wittman would have been prima-facie obvious". Decision, page 3.

Also, at the bottom of page 3 of the Request, appellants state that the Board misapprehended or overlooked the appellants' argument regarding Pan. More particularly, on page 4 of the Request, appellants state that what they argued on page 5 of the brief was that "because Pan does not teach the inclusion of vinyl copolymers in his aromatic carbonate polymers, the flame retardants of Pan may not be combinable with the resin of Wittmann with a reasonable expectation of success".

We do not find any such argument on page 5 of the brief, or in the reply brief. We reproduce below pages 5-6 of the brief in support herein.

> Appellants respectfully contend that the Examiner has failed to do so in the Final Office Action. The only teaching provided by Wittmann et al. at col. 11, line 40, coming at the end of a long "laundry list" of potential ingredients,

> is that flame retardants, deemed customary additives, may be included in their compositions. Thus, Wittmann et al. provide no teaching, nor direction, nor guidance as to how to select any flame retardant. Further, Pan fails to provide the missing teaching to remedy the deficiencies of Wittmann et al.
>
> Pan discloses aromatic carbonate polymers containing a metal oxide of as a flame retardant. Appellants note that the Examiner has failed to point to where Pan discloses or even suggests inclusion of a vinyl copolymer as is instantly claimed. The flame retardants taught by Pan, at col. 2, lines 21-25, are oxides of aluminum, magnesium, lithium, lanthanum, bismuth or yttrium, with high surface area aluminum oxide supported on silica of colloidal particle size being the most preferred. Appellants aver that the Examiner has failed to point to where Pan contains any teaching or suggestion to utilize the instantly claimed water-containing oxides such as aluminum oxide hydroxide. Appellants also note that the examiner has failed to point to where Pan teaches or suggests aluminum phosphates, aluminum sulfates, aluminum sulfides, aluminum hydroxides, aluminum borates and aluminum borophosphoates as is instantly claimed. Further, Wang et al. fails to remedy the deficiencies of Wittmann and Pan.

Brief, pages 5-6.

As made evident above, appellants did not make the statement in the brief that the flame retardants of "Pan may not be combinable with the resin of Wittmann with a reasonable expectation of success". We note that arguments not raised in the brief before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of 37 CFR § 41.52. The pertinent part of this rule is reproduced below, with text in bold for emphasis only:

§ 41.52 Rehearing.

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. **Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.** When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision on appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

(b) Extensions of the time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to

reply for patent applications and § 1.550(c) of this title for extensions of time to reply for exparte reexamination proceedings.

In view of the above, we do not consider appellants' new argument raised in the Request.

We do reiterate our statement made on page 3 of our decision. We stated "[a]ppellants do not dispute that the kind of resins disclosed in Pan are similar to the molding compositions as set forth in Wittmann. Hence, incorporating the teachings of Pan (particular type of flame retardant additive) into the molded compositions of Wittmann would have been prima facie obvious." Appellants pointed out that Pan does not teach use of a vinyl copolymer, but did not present arguments (and, more importantly, any evidence) that the composition of Wittmann is dissimilar such that the flame retardant additive of Pan could not be incorporated into Wittman.

In view of the above, we do not find in the Request any argument convincing us of error in the conclusions we reached in our decision mailed September 30, 2005. Accordingly, appellants' Request for Rehearing is denied.

DENIED

Thomas A. Waltz)
Administrative Patent Judge)
)
)
Peter F. Kratz) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
Beverly A. Franklin)
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